

**REMARKS**

Claims 1, 2, and 4-29 are currently pending in the application. By this amendment, claim 1 is amended and claims 28 and 29 are added for the Examiner's consideration. The above amendments and new claims do not add new matter to the application and are fully supported by the original disclosure. For example, support for the amendments is provided in the claims as originally filed, at Figures 2-11, and at paragraphs [0006], [0041], and [0049], of Applicants' published application (U.S. Pub. No. 2007/0028547). Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

***Restriction Requirement***

In the Office Action dated December 15, 2008, the Examiner withdrew claims 25-27 from consideration as being directed to a non-elected invention, asserting a constructive election by original presentation of the invention recited in claim 1. This restriction is respectfully traversed.

Applicants note that MPEP § 821.03 provides the following guidance regarding constructive election by original presentation:

The practice set forth in this section is not applicable . . . where applicant presents claims that could not have been restricted from the claims drawn to other elected invention had they been presented earlier.

In this case, the Examiner has not even asserted that the inventions recited in claims 25-27 could have properly been restricted from the invention recited in claim 1 had they been presented earlier. That is, the Examiner provides no explanation as to why claims 25-27 are allegedly drawn to patentably distinct inventions. Instead, the Examiner merely identifies features of claims 1 and features of claims 25-27. However, Applicants submit that the existence

of different features, alone, does not constitute an appropriate basis for restricting claims 25-27. Therefore, the restriction is improper and should be withdrawn.

Furthermore, Applicants note that the Examiner's restriction fails to identify one of the two criteria for a proper restriction requirement established by the U.S. Patent and Trademark Office policy. As set forth in MPEP §803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required. In this restriction requirement, the Examiner has not provided any explanation as to the existence of a serious burden if the restriction requirement is not required. Instead, as discussed *supra*, the Examiner merely identifies some different features in the independent claims.

In any event, Applicants submit that there would not be a serious burden if the restriction requirement were not required. This is because the search areas required to examine the invention recited in claims 1, 2, and 4-24 would overlap into the search areas for examining the inventions of claims 25-27, and *vice versa*. Put another way, the search for the combination of features recited in the claims 1, 2, and 4-24 versus claims 25-27, if not totally co-extensive, would appear to have a very substantial degree of overlap.

Because the search for the inventions is substantially the same, Applicants submit that no undue or serious burden would be presented in concurrently examining claims 25-27 with claims 1, 2, and 4-24. Thus, for the above-noted reasons, and consistent with the office policy set forth above in MPEP §803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction and species requirement in this application.

Accordingly, Applicants respectfully request that the restriction requirement be withdrawn, and claims 25-27 examined on the merits.

**35 U.S.C. §102 Rejection**

Claims 1 and 2 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 4,599,841 ("Haid"). Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,086,599 ("Meyerson"). These rejections are respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See, MPEP §2131. Applicants submit that the applied art does not show each and every feature of the claimed invention.

The invention relates to a device for connecting and locking building boards. More specifically, independent claim 1 has been amended to recite, in pertinent part:

...wherein the insert is provided with one resilient lip extending upward from a first side edge directed toward the top side of the insert, and another resilient lip extending downward from a second side edge directed toward the bottom side of the insert, and

wherein at least one of the one resilient lip and the another resilient lip compresses toward a center of the insert and then springs back out from the center of the insert when the boards are connected by substantially horizontal displacement.

Applicants submit that neither Haid nor Meyerson discloses the combination of features recited in claim 1.

Haid discloses a joining moulding 5 having deformable teeth 8. In contrast to the claimed invention, the teeth 8 do not compress inward and then spring back out when the boards 1a and 1b are connected by substantially horizontal displacement. Instead, the teeth 8 merely remain deformed when the boards are pressed together, and there is no disclosure (express or implied) of the teeth 8 springing back out. In fact, it would not even be possible for the teeth 8 to

decompress, as the walls 9a, 9b of the groove would prevent the teeth 8 from springing back. If the teeth 8 were allowed to spring back, the boards 1a, 1b would not be held together. Therefore, Haid does not disclose *at least one of the one resilient lip and the another resilient lip compresses toward a center of the insert and then springs back out from the center of the insert when the boards are connected by substantially horizontal displacement*, as recited in claim 1. Claim 2 depends from independent claim 1, and is distinguishable from Haid at least for the same reasons as claim 1.

Accordingly, Applicants respectfully request that the §102 rejection of claims 1 and 2 in view of Haid be withdrawn.

Meyerson discloses a building panel joint comprising an I-beam 40. As depicted in FIGS. 3A-3D, and as is apparent from FIGS. 15 and 16, when two panels are joined by sliding motion, element 19 first flexes outward away from a center of the I-beam 40, and then springs back inward. This is clearly shown by the arrows of FIGS. 3B and 3C (i.e., outward). This is opposite of the claimed invention, in which *at least one of the one resilient lip and the another resilient lip compresses toward a center of the insert and then springs back out from the center of the insert*. Therefore, Meyerson also fails to disclose all of the features recited in independent claim 1.

Accordingly, Applicants respectfully request that the §102 rejection of claim 1 in view of Meyerson be withdrawn.

### **35 U.S.C. §103 Rejection**

Claims 1, 2, 4, 5, 7-12, and 14-20 are rejected under 35 U.S.C. §103(a) for being unpatentable over WO 00/20705 ("Martensson '705") in view of Haid.<sup>1</sup> Claims 1 and 13 are

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<sup>1</sup> Applicants note that claim 24 also appears to be rejected under §103 in view of Martensson '705 and Haid, as set forth at the paragraph spanning pages 7 and 8 of the Office Action. Applicants request clarification of this issue.

rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Pat. No. 6,763,643 (“Martensson ‘643”) in view of Haid. Claim 6 is rejected under 35 U.S.C. §103(a) for being unpatentable over Martensson ‘705 in view of Haid, and further in view of U.S. Pat. No. 2,863,185 (“Riedi”). Claims 21-23 are rejected under 35 U.S.C. §103(a) for being unpatentable over Meyerson. These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. *See, In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974); *see also, In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). If the prior art reference(s) do not teach or suggest all of the claim limitations, Office personnel must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art (MPEP 2141).<sup>2</sup> Applicants submit that no proper combination of the applied art discloses or suggests the combination of features recited in the claimed invention.

*Claims 1, 2, 4, 5, 7-12, 14-20, and 24 in view of Martensson ‘705 and Haid.*

As discussed supra, Haid does not disclose or suggest *at least one of the one resilient lip and the another resilient lip compresses toward a center of the insert and then springs back out from the center of the insert when the boards are connected by substantially horizontal displacement*, as recited in claim 1. Martensson ‘705 also fails to disclose this feature, such that no proper combination of Martensson ‘705 and Haid teaches the combination of features recited in claim 1.

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<sup>2</sup> While the KSR court rejected a rigid application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying ‘a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does’ in an obviousness determination.” *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).

More specifically, Martensson '705 discloses a joining profile 10 having lips 11 provided with gripping hooks 16. Martensson '705 does not disclose that the gripping hooks 16 compress toward a center of the joining profile 10 and then spring back out from the center of the joining profile 10 when the boards 1 are joined by horizontal movement. To the contrary, there is no teaching in Martensson '705 that the gripping hooks 16 are even flexible or resilient, much less that the gripping hooks 16 compress inward and then spring back outward during joining. Therefore, Martensson '705 does not disclose or suggest *at least one of the one resilient lip and the another resilient lip compresses toward a center of the insert and then springs back out from the center of the insert when the boards are connected by substantially horizontal displacement*, and no proper combination of Martensson '705 and Haid renders claim 1 unpatenable.

Claims 2, 4, 5, 7-12, 14-20, and 24 depend from independent allowable claim 1, and are allowable based on the allowability of claim 1. Moreover, the applied art fails to teach many of the features recited in the dependent claims. For example, no proper combination of Martensson '705 and Haid discloses or suggests *each resilient lip has a tip running obliquely to the top side and bottom side, which tip, for locking, cooperates with an obliquely running edge*, as recited in claim 4. Neither Martensson '705 and Haid discloses or suggests a lip having a tip running obliquely to the top side and bottom side, which cooperates with an obliquely running edge for locking purposes.

Accordingly, Applicants respectfully request that the §103 rejection of claims 1, 2, 4, 5, 7-12, 14-20, and 24 in view of Martensson '705 and Haid be withdrawn.

Claims 1 and 13 in view of Martensson '643 and Haid.

Martensson '643 is a national stage application of Martensson '705, such that the same reasons discussed above with respect to Martensson '705 are applicable for distinguishing the

claimed invention from Martensson '643. Particularly, Martensson '643 does not disclose or suggest *at least one of the one resilient lip and the another resilient lip compresses toward a center of the insert and then springs back out from the center of the insert when the boards are connected by substantially horizontal displacement*, as recited in claim 1. Instead, Martensson '643 only discloses a joining profile 10 having lips 11 provided with gripping hooks 16. Martensson '643 does not disclose that the gripping hooks 16 compress toward a center of the joining profile 10 and then spring back out from the center of the joining profile 10 when the boards 1 are joined by horizontal movement. To the contrary, there is no teaching in Martensson '643 that the gripping hooks 16 are even flexible or resilient, much less that the gripping hooks 16 compress inward and then spring back outward during joining.

Since Haid also fails to disclose compressing inward and then springing back out, as discussed *supra*, Applicants submit that no proper combination of Martensson '643 and Haid discloses or suggest all of the features of independent claim 1. Claim 13 depends from allowable independent claim 1, and is allowable based on the allowability of claim 1.

Accordingly, Applicants respectfully request that the §103 rejection of claims 1 and 13 in view of Martensson '643 and Haid be withdrawn.

Claim 6 in view of Martensson '705, Haid, and Riedi.

Claim 6 depends from allowable independent claim 1, and is allowable based on the allowability of claim 1. As discussed above, Martensson '705 and Haid do not teach or suggest *at least one of the one resilient lip and the another resilient lip compresses toward a center of the insert and then springs back out from the center of the insert when the boards are connected by substantially horizontal displacement*, as recited in claim 1. Riedi also fails to disclose this

feature, such that no proper combination of the applied art teaches the combination of features recited in claim 1, from which claim 6 depends.

Accordingly, Applicants respectfully request that the §103 rejection of claim 6 in view of Martensson '705, Haid, and Riedi be withdrawn.

Claims 21-23 in view of Meyerson.

Claims 21-23 depend from allowable independent claim 1, and are allowable based on the allowability of claim 1. As discussed above, Meyerson does not disclose or suggest the combination of features recited in claim 1, from which claims 21-23 depend.

Accordingly, Applicants respectfully request that the §103 rejection of claims 21-23 in view of Meyerson be withdrawn.

***New Claims***

Claims 28 and 29 are added by this amendment and are believed to be distinguishable from the applied art at least for the following reasons. Claims 28 and 29 depend from allowable independent claim 1, and are distinguishable from the applied art at least for the reasons discussed above with respect to claim 1. Moreover, claims 28 and 29 depend in a serial manner from independent claim 1, each additional dependent claim reciting additional features that further define the claimed invention.



### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,  
Thomas GRAFENAUER

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', is written over a horizontal line.

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